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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,492	07/22/2003	Jerry Yao	BHT-3117-143	6344

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EXAMINER

TRUONG, THANH K

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/623,492

**Applicant(s)**

YAO, JERRY

**Examiner**

Thanh K Truong

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on November 15, 2004.
2. Applicant's cancellation of claims 1-11 is acknowledged.

### ***Specification***

3. The amendment filed November 15, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

On page 3 of the amendment filed November 15, 2004, the phrase: "engineering plastic, or reinforced plastic" (lines 7), "twice" (line 14), and "or rectangular-shaped" (lines 27).

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 17, 18 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The recitations: "engineering plastic material" (claim 17, lines 2-3), "reinforced plastic material" (claim 18, lines 2-3) and "twice a thickness" (claim 20, line 2) are not disclosed in the original specification, thus these features are considered new matter and should be removed from these claims.

Accordingly, claims 17, 18 and 20 will not be examined in this office action; these claims will be examined on the merits when the 112 issue is resolved.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "wherein the at least one of the two opposing sides of the interior includes both of the two opposing sides" (lines 1-2) is confusing, for it is unclear what is the limitation of the claim?

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12, 13, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hou et al. (5,615,819) in view of Ohuchi (5,816,469).

Hou discloses (figures 3, 4, 5A, 5B and 7) an apparatus comprising:

a plurality of parallel nail guiding-grooves 41, 51 symmetrically located on two opposing sides of an interior thereof, each of the plurality of parallel nail guiding grooves located on at least one of the two opposing sides having:

at least one wall located between adjacent nail guiding grooves of the plurality of nail guiding-grooves (figure 4);

a combining groove.

Hou discloses the claimed invention, but does not expressly disclose the abrasion-resistant plate located in the combining groove and having a rectangular cross section.

Ohuchi discloses (figure 2) an apparatus comprising the abrasion-resistant plate 10 located in the combing groove for supporting the head 3b of nail 3 and reducing damage to the magazine internal nail grooves (column 2, lines 44-47); in the longitudinal cross section view (along the length of the magazine), the abrasion-resistant plate 10 would having a rectangular cross section. Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Hou's apparatus by incorporating the insertion of the abrasion-resistant plate as taught by Ohuchi so that each combining groove will be cover with the

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abrasion-resistant plate for reducing the friction and wear that causes by the movement of the nails in the grooves.

The modified reference of Hou further discloses: a pair of abrasive resistant plates engaging the top surface of the nail heads of the nail row (as discussed above, Ohuchi's abrasion-resistant plate 10 was install to prevent the friction between the nail head and the groove – see column 2, lines 44-47) as in claim 13; the plurality of parallel nail guiding-grooves are integrally formed of an aluminum alloy (column 1, lines 26-27) as in claim 16; and each abrasion-resistant plate is a steel plate having a high strength and a high wear resistance (column 2, lines 44-47) as in claim 19.

10. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hou et al. (5,615,819) in view of Ohuchi (5,816,469) and further in view of Slemker et al. (6,228,124).

As discussed above in paragraph 9 of this office action, the modified reference of Hou discloses the claimed invention, but does not expressly disclose the positioning rib located on each abrasion-resistant plate, wherein each positioning rib inserted into one positioning groove.

Slemker discloses an apparatus wherein the positioning rib 49 of member 22 is inserted into the positioning groove of member 14 to provide a locking mechanism between the two members (figure 3). Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Hou's apparatus by incorporating the positioning rib and groove between two

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member as taught by Slemker for creating a locking mechanism between the abrasive-resistant plates and the grooves.

Slemker further discloses the positioning groove and the positioning rib have a V-shaped cross section.

### ***Response to Arguments***

11. Applicant's arguments filed November 15, 2004 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Both references Grikis et al. (4,389,012) and Hamano et al. (6,592,016) disclose the teach of employing the abrasion-resistant plate inside the nail guiding grooves to prevent wear and friction between nail head and the groove internal surfaces. DeVivi (6,581,351) and Andersson (6,029,416) disclose the use of positioning rib and positioning groove between two surfaces.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K Truong whose telephone number is (571) 272-4472. The examiner can normally be reached on Mon-Thurs from 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tkt  
January 31, 2005.



Rinaldi I. Rada  
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